



UNITED STATES
PATENT AND
TRADEMARK OFFICE

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UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY
AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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In re Application of :
Meike Lorenz et al :
Serial No.: 09/816,697 : PETITION DECISION
Filed: March 23, 2001 :
Attorney Docket No.: 08702.0005-00000 :

This is in response to applicants' petition under 37 CFR 1.181, filed June 25, 2001, seeking acceptance of a reply as timely.

BACKGROUND

A review of the file history shows that this application was filed on March 23, 2001. According to applicants the examiner telephoned applicants' representative during the week of February 4, 2002, proposing a restriction requirement and seeking a telephonic election. A formal written restriction requirement was mailed to applicants at the address of their representatives, Lahive and Cockfield, on February 11, 2002. Applicants indicate that a telephone call was made to the examiner prior to March 4, 2002, in which an election with traverse was made. Applicants' present representatives indicate that the Office action was not received by them until March 5, 2002, as it was sent to applicants' previous representatives. Applicants aver that after receiving the Office action that a telephone call was made to the examiner to determine if a formal written response was required with the examiner replying that none was needed. Thus no written reply was forwarded to the Office until later inquiry determined that the examiner had left the Office without any further action on the application.

DISCUSSION

It is Office policy when making a restriction requirement in an application to inquire of applicants or their representatives whether they are willing to make a telephonic election. Determination of whether to propose a restriction requirement by telephone is made by the examiner based on the complexity of the requirement with the result being incorporated as part of the next Office action. Where there are groups of claims directed to less than five distinct and independent inventions a telephonic request is almost always made. Where there are more than ten groups, or other

complicating factors exist, the requirement is almost always written. Examiners, when making a telephonic request, frequently allow an applicant a few days to consider the proposed requirement and respond with a telephonic election. In this application, according to applicants' representative, a telephone restriction requirement was proposed with applicant requesting time to consider the requirement before making an election. It is not clear if or when applicant actually replied by telephone, however it appears not to have been within a reasonable time period in the examiner's opinion. Thus the examiner mailed a written restriction requirement to applicants at the address of record approximately one week after first making a telephonic proposal.

It is noted that applicants' petition does not indicate who received the proposed telephonic restriction requirement nor who purportedly replied by telephone. It is also not clear as to when the present attorneys became responsible for the prosecution of this application. It is, however, clear that a new Power of Attorney appointing the above attorneys as applicants' representatives was not filed until May 17, 2002, fully three months after the requirement was mailed, and two months after it was received by the present representatives of applicants. It is also regrettable that no record of any telephone calls made or received by the examiner exist in the file. Applicants have also failed to provide any evidence of telephone calls received from or made to the Office.

It is clear from the rules of practice as well as the guidelines of M.P.E.P. 812.01 that when telephone practice for making a restriction requirement fails to elicit an election in a timely manner an Office action is mailed to applicants formally setting forth the restriction requirement and setting a period for reply, usually one month which may be extended under 37 CFR 1.136(a), within which applicants must reply (see M.P.E.P. 701-710.02(e)). Although a telephone reply can be made, a formal written reply is required. Applicants did not file a formal written reply until June 25, 2002, thus requiring an extension of time of four months and the fee therefor.

DECISION

Applicants' petition is **DENIED**.

The application will be forwarded to the examiner for further action commensurate with the response to the restriction requirement.

Should there be any questions with respect to this decision, please contact William R. Dixon, Jr., by mail addressed to: Director, Technology Center 1600, Washington, D.C. 20231, or by telephone at (703)308-3824 or by facsimile transmission at (703) 305-7230.



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